

**BARNES & THORNBURG LLP**

600 One Summit Square
Fort Wayne, Indiana 46802
(260) 423-9440

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Customer No.: 23641

Application No.: 09/810304

Confirmation
No.: 9103

Filing Date: March 16, 2001

Group Art
Unit: 3629

Examiner
Name: Jonathan P. Ouellette

Attorney
Docket No.: 26893/82373

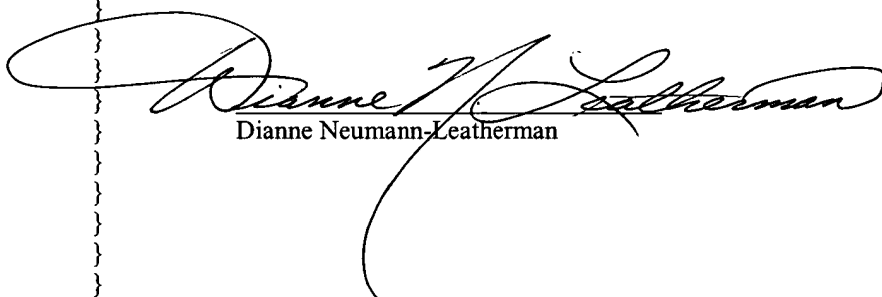
First Named
Inventor: DeTore, Arthur W.

Title: METHOD FOR
STRUCTURING
UNSTRUCTURED DOMAINS
TO CREATE VALUE

Certificate Under 37 CFR 1.8(a)

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P. O. Box 1450, Alexandria, VA 22313-
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on June 14, 2006


Dianne Neumann-Leatherman

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- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
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- ☐ CD, Number of CD(s) _____
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☒ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)

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☐ Status Letter

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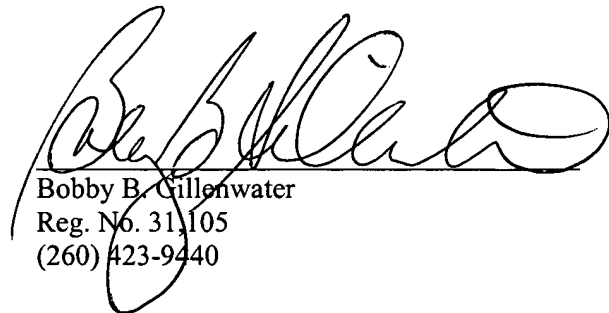
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 Bobby B. Gillenwater
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 (260) 423-9440

Date: June 14, 2006

AF 13629
JF



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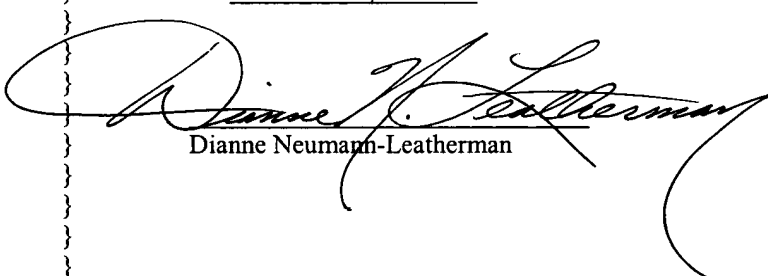
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22313-1450

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FEE TRANSMITTAL FOR FY 2006

TOTAL AMOUNT OF PAYMENT: \$ 620.00

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge any additional fee required
under 37 CFR 1.16 and 1.17 and credit any overpayments to:

Deposit Account Number: 02-1010 (26893/82373)

Deposit Account Name: Barnes & Thornburg LLP

- ☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☒ **Check** ☐ Credit Card ☐ Money Order ☐ Other ☐ None

FEE CALCULATION

1. Basic Filing Fee:

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description	Fee Paid
1011	\$300.00	2011	\$150.00	Utility Filing Fee	
1012	\$200.00	2012	\$100.00	Design Filing Fee	
1017	\$200.00	2017	\$100.00	Design Filing Fee (CPA)	
1013	\$200.00	2013	\$100.00	Plant Filing Fee	
1014	\$300.00	2014	\$150.00	Reissue Filing Fee	
1005	\$200.00	2005	\$100.00	Provisional Filing Fee	
				SUBTOTAL (1)	0.00

2. Patent Search Fees:

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description	Fee Paid
1111	\$500.00	2111	\$250.00	Utility Fee	
1112	\$100.00	2112	\$50.00	Design Fee	
1113	\$300.00	2113	\$150.00	Plant Fee	
1114	\$500.00	2114	\$250.00	Reissue Fee	
				SUBTOTAL (2)	0.00

3. Patent Examination Fees:

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description	Fee Paid
1311	\$200.00	2311	\$100.00	Utility Examination Fee	
1312	\$130.00	2312	\$65.00	Design Examination Fee	
1313	\$160.00	2313	\$80.00	Plant Examination Fee	
1314	\$600.00	2314	\$600.00	Reissue Examination Fee	
				SUBTOTAL (3)	0.00

4. Extra Claim Fees:

			Extra Claims	Fee from Below	Fee Paid
Total Claims	_____	-20**=	_____ x	_____ =	0.00
Independent Claims	_____	- 3**=	_____ x	_____ =	0.00
Multiple Dependent Claim	_____			_____ =	0.00
				SUBTOTAL (4)	0.00

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description
1202	\$50.00	2202	\$25.00	Claims in excess of 20
1201	\$200.00	2201	\$100.00	Independent claims in excess of 3
1203	\$360.00	2203	\$180.00	Multiple dependent claims, if not paid

1204	\$88.00	2204	\$44.00	** Reissue independent claims over original patent
1205	\$18.00	2205	\$9.00	** Reissue claims in excess of 20 and over original patent

** or number previously paid, if greater; For Reissues, see above. For multiple dependent claims, pay fee only once no matter how many multiple dependent claims you have.

5. Application Size Fee

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250.00 (\$125.00 for small entity) for each additional 50 sheets or fraction thereof.

	Extra Sheets	Number of each additional 50 (Round up to whole number)	Fee from Below	Fee Paid
Total Sheets	<u> </u> - 100 = <u> </u> / 50 = <u> </u>			
			SUBTOTAL (5)	0.00

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description
1081	\$250.00	2081	\$125.00	Sheets in excess of 100

6. Additional Fees:

Large Fee Code	Entity Fee	Small Fee Code	Entity Fee	Fee Description	Fee Paid
1051	\$130.00	2051	\$65.00	Surcharge - late filing fee or oath	
1052	\$130.00	1052	\$130.00	Surcharge - late provisional filing fee or cover sheet	
1053	\$130.00	1053	\$130.00	Non-English specification	
1812	\$2,520.00	1812	\$2,520.00	For filing a request for ex parte reexamination	
1804	\$920.00*	1804	\$920.00*	Requesting publication of SIR prior to Examiner action	
1805	\$1,840.00*	1805	\$1,840.00*	Requesting publication of SIR after to Examiner action	
1251	\$120.00	2251	\$60.00	Extension for reply within first month	\$120.00
1252	\$450.00	2252	\$225.00	Extension for reply within second month	
1253	\$1,020.00	2253	\$510.00	Extension for reply within third month	
1254	\$1,590.00	2254	\$795.00	Extension for reply within fourth month	
1255	\$2,160.00	2255	\$1,080.00	Extension for reply within fifth month	
1401	\$500.00	2401	\$250.00	Notice of Appeal	
1402	\$500.00	2402	\$250.00	Filing a brief in support of an appeal	\$500.00
1403	\$1,000.00	2403	\$500.00	Request for oral hearing	
1451	\$1,510.00	1451	\$1,510.00	Petition to institute a public use proceeding	
1452	\$500.00	2452	\$250.00	Petition to revive - unavoidable	
1453	\$1,500.00	2453	\$750.00	Petition to revive - unintentional	
1501	\$1,400.00	2501	\$700.00	Utility issue fee	
1502	\$800.00	2502	\$400.00	Design issue fee	
1503	\$1,100.00	2503	\$550.00	Plant issue fee	
1504	\$300.00	1504	\$300.00	Publication Fee for early, voluntary, or	

				normal Publication	
1460	\$130.00	1460	\$130.00	Petitions to the Commissioner	
1807	\$50.00	1807	\$50.00	Processing fee for provisional applications	
1808	\$130.00	1808	\$130	Processing fee, except for provisional applications	
1806	\$180.00	1806	\$180.00	Submission of Information Disclosure Statement	
8021	\$40.00	8021	\$40.00	Recording each patent assignment per property (times number of properties)	
1809	\$790.00	2809	\$395.00	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	\$790.00	2810	\$395.00	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	\$790.00	2801	\$395.00	Request for Continued Examination (RCE)	
1802	\$900.00	1802	\$900.00	Request for expedited examination of a design application	
Other fee (specify): _____					
*Reduced by Basic Filing Fee Paid					
SUBTOTAL (6)					620.00

Date: June 14, 2006



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**BEFORE THE BOARD OF PATENT
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Patents, P. O. Box 1450,
Alexandria, VA 22313-1450

on June 14, 2006



Dianne Neumann-Leatherman

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

06/16/2006 NNGUYEN1 00000094 09810304

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Sir:

A Notice of Appeal was filed in this application in accordance with 37 CFR §41.31(a) on March 23, 2006. This Appeal Brief is filed in accordance with 37 CFR §41.37. The requisite fee of \$500.00 accompanies this brief pursuant to 37 CFR §41.20(2). A petition for an extension of the period for response, with accompanying fee in the amount of \$120.00, also accompanies this brief. Please credit any overpayment or charge any additional fees to the Deposit Account of Barnes & Thornburg LLP, Account Number 02-1010 (26893/82373).

REAL PARTY IN INTEREST

Appellants have assigned their interest in this case to Swiss Re Insurance Company of Zurich, Switzerland (hereinafter "Appellant"). The assignment was recorded in the United States Patent and Trademark Office at Reel 013383 and Frame 0680, on October 15, 2002.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the inventors, Appellant, or Appellant's legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF THE CLAIMS

Claims 19-32 are pending in this application. Original Claims 1-18 were cancelled, without prejudice, and are not at issue in this appeal. Claims 19-32 stand rejected under 35 U.S.C. Section 102(e), as detailed in the Final Office Action mailed on October 28, 2005. The claims appealed are all of Claims 19-32.

STATUS OF AMENDMENTS

No amendments to the claims were filed following final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The following summary is provided in accordance with 37 C.F.R. § 41.37(c)(v) and M.P.E.P. §1206 and correlates claim elements or steps to specific embodiments described in

the specification. Consistent with M.P.E.P. §1206, the following summary is not intended in any manner whatsoever to limit the scope of the claims beyond the plain language of the claims themselves. Rather, the summary is provided to enable the Board to more quickly determine where the claimed subject matter is described in the application and to facilitate the Board's understanding of the subject matter of the appeal.

The subject invention is a method for systematically adding structure to elements of information associated with a relatively unstructured domain or body of knowledge. The addition of structure to the relatively unstructured elements of the domain is done for the purpose of, and only on the condition of, imparting added value to the domain.

A glossary of terms used in the specification and claims is included in the specification at pages 8 and 9. For convenience of reference, the glossary from the specification is included in the Evidence Appendix of this brief.

Claim 19 is the only independent claim on appeal. For ease of reference, the text of independent claim 19 is set forth below. The first occurrence of terms which appear in the above-mentioned glossary are printed in bold in the text of claim 19, and throughout the remainder of this brief.

19. A method of structuring contents of an **unstructured domain** so as to impart value to the **domain**, comprising the steps of:

identifying a plurality of elements of information associated with an unstructured domain;

developing an **initial domain model** for utilizing the plurality of elements of information associated with the domain to create value;

developing an estimate of costs associated with developing a **knowledge map** cataloging and describing at least some of said elements of information associated with the domain, and developing an estimate of the value of said knowledge map;

comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said plurality of elements of information; and

developing and storing the knowledge map so as to add structure and impart value to said domain.

Claim 19 sets forth the steps of a method for systematically providing an increased degree of order or structure to a user-selected body of unordered (i.e., unstructured) information associated with a particular domain. In the claimed method, additional order is provided only after a comparison of estimates of costs and value associated with the increased order. The steps of Claim 19 are illustrated by elements of the flow chart of Figure 1 identified by reference numerals 2, 4, 5, 6, 7, 12 and 14. This portion of the flow chart of Figure 1 is discussed at page 10 of the specification. The step of developing an initial domain model is further illustrated in the flow chart of Figure 2. The detailed description of Figure 2 begins on line 22 of page 11 and continues through line 17 of page 14. The step of developing a knowledge map is further illustrated in the schematic representation of a knowledge map in Figure 3, described beginning on page 17, line 13.

Dependent Claims 20-26 further define the step of developing an initial domain model. Developing the initial domain model is the first step in structuring the subject domain, pursuant to the method of Claim 19, and may be the last step as well unless additional structuring is economically justified in accordance with the decision operation at **gate 5** in Figure 1.

Dependent Claim 27 depends from Claim 19 and adds additional steps which are illustrated in the flow chart of Figure 1 by reference elements 8, 9 and 16. The additional steps added by dependent Claim 27 involve developing an estimate of costs associated with development of a **knowledge clearing house**, developing an estimate of the value of such knowledge clearing house, comparing the estimates and, based on the comparison, developing and storing the knowledge clearing house to create a highly **structured domain**. A schematic

representation of an illustrative knowledge clearing house is presented in Figure 4 of the drawings. Figure 4 is described in the specification beginning in line 12 of page 19.

Dependent Claims 28-32 all depend, directly or indirectly, from dependent Claim 27. Dependent Claim 31 adds steps relating to development of a **knowledge network**. Development of a knowledge network, if warranted by a comparison of estimates of costs and value, results in creation of a fully-structured domain. These steps are illustrated in the flow chart of Figure 1 by elements 10 and 18. A knowledge network is defined in the glossary beginning in line 1 on page 9 and is illustrated in Figure 5. The illustrative knowledge network of Figure 5 is described in the specification beginning at line 16 of page 22.

GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented in this appeal are whether each of Claims 19-32 are anticipated under 35 U.S.C. Section 102(e) by U.S. Patent No. 6,044,354 to Asplen, Jr. ("Asplen").

ARGUMENT

I. THE EXAMINER ERRED IN REJECTING CLAIMS 19-32 AS ANTICIPATED IN VIEW OF ASPLEN.

Appellant respectfully submits that the Examiner erred in rejecting Claims 19-32 under 35 U.S.C. Section 102(e) as anticipated by Asplen. A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently. See Hasani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). As discussed in connection with individual claims below, the Examiner has not demonstrated that Asplen discloses each and every element of the claims on appeal, and Asplen does not in fact do so.

II. THE ASPLEN PATENT

Asplen discloses a computer based "product planning system." The Asplen system is said to provide "for uniform product planning throughout an organization while insuring thoroughness, control and rapid implementation." (Abstract) With reference to the

description in column 2, lines 23 - 41, the Asplen system includes five “chapters” or stages, including idea assessment, market opportunity assessment, business planning, implementation planning and product launch. Each chapter is associated with tasks organized into sections and subsections, with listings of associated tasks that are customized for particular products. A responsible person is assigned to each chapter and each task to be implemented. When the tasks of a chapter are complete, the chapter is marked as being complete by the responsible person. The chapters are taken up in sequence, although some chapters and tasks may be omitted and other tasks may be added for particular products. The purpose of the system is to control the planning process from idea development to product launch. The term “product” is defined as including “goods, services, projects and the like.”

Appellants respectfully submit that the computer system disclosed by Asplen is a highly specialized system directed to a highly particularized task (i.e., development and launch of a “product”). In contrast, the invention of the claims on appeal relates to a structuring/mapping tool that is *a priori* not task- or target-oriented. The Asplen product planning system is a tool used to gather data to accomplish a specific goal. The invention of the claims on appeal, on the other hand, is a tool that is brought to bear on an identified body of existing data to impart increasing levels of structure and value to such data. Appellants respectfully submit that these tools do not relate to the same technical field (i.e., product planning versus structuring of data). One skilled in the art of data structuring in accordance with the claimed invention is not necessarily competent in the field of product planning, and vice versa.

III. INDEPENDENT CLAIM 19

Appellants claimed invention is directed to a method of structuring (or adding structure to) the contents of an unstructured domain so as to impart or add value to the domain. A domain is defined as “a particular body of knowledge, and a set of methods for creating, sharing and using that body of knowledge to achieve a given purpose.” An unstructured domain is a domain that is less-clearly defined or organized than its structured counterpart. The steps of Claim 19 include identifying plural elements of information associated with an unstructured domain, developing an initial domain model for utilizing those elements to create value, developing an estimate of costs associated with adding structure (e.g., developing a knowledge

map) for at least some of those elements of information, and developing an estimate of the added value. The estimates of costs and value are compared and, based on that comparison, at least one of the steps of storing and maintaining the initial model and elements of information, and developing and storing the knowledge map so as to add structure and impart added value to the domain are performed.

Appellants respectfully submit that such a method is not disclosed by Asplen. Even if one assumes, *arguendo*, that the product planning system illustrated in Figures 1a-5 of Asplen constitutes a “domain” (i.e., a particular body of knowledge, and a set of methods for creating, sharing and using that body of knowledge to achieve a given purpose), Asplen discloses no method for structuring the contents of such domain, much less that particular method claimed by Appellants. For example, even accepting (solely for the sake of argument) that the individual “tasks” associated with each of the “chapters” may be characterized as “elements of information associated with an unstructured domain,” Asplen does not disclose “developing an initial domain model.” Nor does Asplen disclose developing an estimate of costs associated with developing a knowledge map cataloging and describing at least some of the elements associated with the domain, and developing an estimate of the value of the knowledge map. Moreover, Asplen does not disclose comparing such estimates and, based on such comparison, performing at least one of the steps of storing and maintaining the model and elements of information, and developing and storing the knowledge map so as to add structure and impart value to the domain. Appellants respectfully submit that, to the extent Asplen discloses a method, it is a method of product planning used in conjunction with the product planning system described and illustrated. Asplen does not disclose how such system/method was developed, and certainly does not disclose the steps of the particular method set forth in Claim 19, as discussed above.

The Examiner’s rejection of Claim 19, as set forth in numbered paragraph 5 of the DETAILED ACTION, is almost wholly conclusory. Following the words “Asplen discloses” the Examiner simply recites the entirety of Appellants Claim 19. The only additions by the Examiner to Appellants claim language are found in three parentheticals in lines 5, 7/8, and 12 of numbered paragraph 5. The first parenthetical contains the words “idea assessment” following the step of developing an initial domain model. The term “idea assessment” is used synonymously with the term “idea management” by Asplen as the title of the first of the five

“chapters” which make up Asplen’s system. (See Fig. 1a). This chapter includes “tasks” or “subchapters” which apparently call for the entry of elements of information relating to a new idea. Appellants respectfully submit that Asplen’s intent in this regard is to gather information, rather than add structure to a previously identified collection of unstructured elements of information.

The second parenthetical contains the words “opportunity assessment” following the step of developing an estimate of costs associated with developing a knowledge map cataloging and describing elements of information associated with a domain. The term “opportunity assessment” is used by Asplen as the title of the second chapter of his product planning system (see Fig. 2). While the tasks associated with this chapter include market assessment, competitive assessment, financial implications, etc., these tasks are not synonymous with the step of developing an estimate of costs associated with developing a knowledge map cataloging and describing elements of information associated with a domain, as set forth in the claim. The various tasks performed under the opportunity assessment chapter by Asplen’s system are intended to assess the market potential of a new product. They are not associated with, nor ultimately used in the decision to proceed with or forego, the addition of structure to a particular domain.

Finally, the third parenthetical contains the words “business plan” following the step of developing and storing a knowledge map. This parenthetical also includes the only “specific” reference to portions of the Asplen patent relied on by the Examiner. Those references (Abstract, Figs. 1a-5, Claim 1), however, are so broad and general as to be totally useless. The term “business plan” is used as the title of Asplen’s third chapter. (See Fig. 3) The various subheadings or tasks associated with this chapter appear to have a data gathering function for the purpose of assembling a business plan associated with a new product idea. While a business plan can be a valuable tool or document in the context of new product development, Appellants respectfully submit that such is not “a device for structuring the content scope of a domain by cataloging and describing the key contents sources in the domain.”

Appellants understand that Examiners will give claims their broadest reasonable interpretation consistent with the specification, and that limitations appearing in the specification

will not be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ1, 5 (Fed. Cir. 1985). However, the Examiner appears to have afforded no weight whatsoever to the fact that several terms in Claim 19 (as set forth in bold text above) are expressly defined in the glossary set forth in the specification. At least, to the extent such consideration was given by the Examiner, such is not at all apparent from the Examiner's stated basis for rejection in numbered paragraph 5 of the Detailed Action. Appellants respectfully submit that Claim 19 must be interpreted in light of the specification, and particularly in light of specific terms which are expressly defined in the specification.

Moreover, Appellants respectfully submit that it is incumbent upon the Examiner, when rejecting a claim as being anticipated (either expressly or inherently) by a prior art reference, to identify disclosures in that reference corresponding to each of the elements or steps of the claim in question with more specificity than was done in this case. Such disclosures constitute the "evidence" upon which the Examiner's finding of anticipation rests, and to which Applicants/Appellants are entitled to respond and test. "Broad conclusory statements regarding the teaching of [multiple] references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617.¹ Appellants respectfully submit that the Examiner erred in this regard when examining Claim 19 and, as will be set forth below, all of the other claims on appeal.

Accordingly, Appellants respectfully submit that the Examiner's rejection of Claim 19 is in error and should be reversed.

IV. DEPENDENT CLAIM 20

Dependent Claim 20 further defines the step of developing an initial domain model as comprising at least one of four additional steps: defining an **organizational scope**; defining a content scope; defining a **process scope**; and defining economic factors relating to the domain. Organizational scope is discussed and defined beginning in line 1 on page 12 of the specification. In short, organizational scope refers to parts of an organization which fall within

¹ Although *Dembiczak* dealt with this issue in connection with multiple references cited in a rejection under Section 103, Appellants respectfully submit that the requirement holds for rejections under Section 102, as well.

the definition of, or are impacted by, an unstructured domain. Content scope is defined on page 12 beginning in line 13. Content scope defines the types of knowledge or information that will be considered and included in the domain. Process scope is defined on page 13 beginning in line 11. Process scope identifies processes that should be improved through structuring of the unstructured domain. As noted in the specification, defining such a scope can be an important indicator of at least some value that will result by structuring the domain. Finally, the economic factors referred to in Claim 20 are discussed in the specification at page 13 beginning in line 15.

In rejecting Claim 20, the Examiner continues the conclusory pattern set in paragraph 5 of the Detailed Action in stating that “Asplen discloses” followed by a verbatim quote of the claim language. No attempt whatsoever is made to equate the terms of Claim 20 to a specific term or specific disclosure in the Asplen patent. Appellant respectfully submits that such a rejection is wholly improper.

Appellants respectfully submit that Asplen does not include the step of developing an “initial domain model” (which is defined in the glossary as refined information about the subject unstructured domain). Moreover, Asplen does not disclose the step of developing such an initial domain model that comprises at least one of the four component steps set forth in Claim 20.² Appellant respectfully submits that the absence of these limitations in Asplen is evidenced by the Examiner’s inability to identify the same in the Detailed Action.

Appellants respectfully submit that, when viewed in a light most favorable to the Examiner, Asplen arguably shows a “domain” that has been structured to accomplish a specific result (i.e., product planning). However, the particular method by which such structure was imparted to such “domain” is neither disclosed nor suggested. This fact illustrates a significant difference between the disclosure of Asplen and the subject matter of Appellants’ application and claims. Namely, Asplen’s disclosure relates to a system which is designed to gather information to be used for the specific purpose of product planning. Appellants’ method, on the

² The undersigned is well aware that “[M]ere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak* 175 F. 3d at 999, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas Power & Light Co.*, 995 F. 2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). However, requiring Appellants to prove that Asplen does not disclose certain steps of the claim in the absence of any specific evidence identified to the contrary by the Examiner amounts to requiring Appellants to “prove a negative.”

other hand, is not a data-gathering tool. It is a specific method for imparting structure to identified bodies of information, by degrees and only to the extent increased levels of structure are justified by the creation or addition of value in excess of the costs of the added structure. Accordingly, the Examiner's rejection of Claim 20 is in error and should be reversed.

V. DEPENDENT CLAIM 21

This claim depends from Claim 20 and further defines the step of defining the organizational scope (defined above and in the specification) that, in certain embodiments, is part of the step of developing an initial domain model. Appellants respectfully submit that this claim is allowable for at least the same reasons discussed in connection with independent Claim 20. Appellants also note that, as in the case of Claim 20, the Examiner's rejection utterly fails to identify any disclosure in Asplen which corresponds to the limitations of dependent Claim 21. Accordingly, the Examiner's rejection of Claim 21 is in error and should be reversed.

VI. DEPENDENT CLAIM 22

Claim 22 depends from dependent Claim 20 and further defines the step of defining the content scope as comprising the step of identifying at least some of the plurality of elements of information as either **explicit content** or **implicit content**. This claim is respectfully submitted by Appellant to be allowable for at least the reasons set forth in connection with Claim 20, and for the further reason that Asplen does not disclose identification of existing elements of information as being either explicit or implicit content. Explicit content is defined in the glossary as "content that is not exclusively people-based, including documents, databases, email and so on. The content can be online or offline." Implicit content is defined as "information held in the mind of an individual or collectively in the minds of teams or groups." Asplen does not so identify or classify the elements of information gathered by his system. As with the other claims, the Examiner's stated rejection of Claim 22 (despite the vague parentheticals) is wholly conclusory. Accordingly, the Examiner's rejection of Claim 22 is in error and should be reversed.

VII. DEPENDENT CLAIM 23

This claim depends from dependent Claim 22. As such, it is considered to be allowable for at least the reasons set forth in connection with Claims 20 and 22. Moreover, there

is no disclosure in Asplen (and none is identified by the Examiner) to suggest that elements of information are identified as being either online information or offline information, as stated in the claim. Accordingly, the Examiner's rejection of Claim 23 is in error and should be reversed.

VIII. DEPENDENT CLAIM 24

Dependent Claim 24 depends from Claim 20 and further defines the step of defining a process scope, which in some embodiments is a component step of developing the initial domain model. Dependent Claim 24 adds to the limitations of Claim 20 the limitation of identifying a business process that can be improved by structuring the contents of the unstructured domain. As with all the other rejections, the Examiner's treatment of dependent Claim 24 is wholly conclusory and without any basis or foundation in the Asplen disclosure. Accordingly, the Examiner's rejection of Claim 24 is in error and should be reversed.

IX. DEPENDENT CLAIM 25

This claim depends from dependent Claim 20 and further defines the step of defining economic factors, which may be a component step of developing an initial domain model. Claim 25 recites several steps which may exist individually or in combination. Asplen does not disclose any comparable "cost identifying" steps. To the extent Asplen refers to economic factors (e.g., "billing and accounting plan," "financial/budget"), he is referring to factors relating to the particular product under development. He is not referring to the costs associated with identifying or gathering the information associated with his product planning system, or of costs associated with detecting errors and taking actions to avoid and correct errors in such information, or identifying communication costs relating to such information, or identifying costs associated with maintaining the information in his product planning system. This further illustrates the significant difference between the claimed method and the Asplen system which is referred to above in the last paragraph of Section IV.

In rejecting Claim 25 in numbered paragraph 11 of the Detailed Action, the Examiner again simply recites the language of the claim and asserts, without foundation or support, that Asplen discloses such steps. Accordingly, the Examiner's rejection of Claim 25 is in error and should be reversed.

X. DEPENDENT CLAIM 26

Dependent Claim 26 depends from Claim 20 and further defines the step of defining economic factors as comprising the step of developing an economic model for use in developing the estimates of costs and value associated with developing a knowledge map. Such a step of developing an economic model to be used for the purpose stated is neither explicitly nor inherently disclosed by Asplen. Even if, *arguendo*, the chapters and/or tasks diagrammed in the Asplen patent may be characterized as a knowledge map, (i.e., a device for structuring the content scope of a domain by cataloging and describing the key content sources in the domain”), Asplen does not develop an economic model for use in developing estimates of the costs and value associated with developing same. Any economic factors or “models” referred to in Asplen are clearly intended to be externally directed to the product or idea under development, and not internally directed to the Asplen system itself. As with all the other claims, the Examiner fails to identify any portion of the Asplen disclosure to suggest otherwise. Accordingly, the Examiner’s rejection of Claim 26 is in error and should be reversed.

XI. DEPENDENT CLAIM 27

Dependent Claim 27 depends from independent Claim 19. This claim adds several steps to the method of Claim 19, including the step of developing an estimate of costs associated with developing a knowledge clearing house. A knowledge clearing house is defined in the glossary as “a central agency for the collection, classification, and distribution of information or transactions within the domain.” The intended purpose of the knowledge clearing house referenced in Claim 27, as stated in the claim, is to provide centralized access to online elements of information associated with the domain and a cataloging of offline elements of such information. This step of Claim 27 further includes developing an estimate of the value of the knowledge clearing house.

After the estimate of costs and value associated with developing the knowledge clearing house are developed, the claim requires that these estimates be compared and, based upon the comparison, at least one of the following two steps are performed: the previously developed model, plurality of elements of information, and the previously developed knowledge

map are stored and maintained; and the knowledge clearing house is developed so as to add additional structure and impart value to the domain.

In rejecting this claim, the Examiner simply quotes the claim language and baldly concludes that Asplen discloses such steps. (See paragraph 13 of the Detailed Action). As previously discussed, Appellants respectfully submit that such rejection is improper and should be reversed. Further, Appellants submit that Asplen discloses nothing of the kind. With the benefit of hindsight, one might be able to pick and choose from among the chapters/tasks identified by Asplen in an effort to identify “online elements of information” or “offline elements of information” or other individual aspects of Appellants claimed method. However, when viewed in context, it is clear that the method claimed by Appellants dependent Claim 27 is not at all disclosed by Asplen’s patent, and that such methods differ substantially from Asplen’s product planning system. Appellants respectfully submit, as previously noted above, that the Examiner’s apparent inability to identify any specific portions of the Asplen disclosure as disclosing the steps of Claim 27 is, in itself, evidence enough to support Appellants’ position. Accordingly, the Examiner’s rejection of dependent Claim 27 is in error and should be reversed.

XII. DEPENDENT CLAIM 28

Dependent Claim 28 depends from dependent Claim 27 and further defines the step of developing an estimate of the value of the knowledge clearing house. Specifically, dependent Claim 28 requires that this step comprise the step of creating a model for determining how additional value will be created by structuring the domain beyond the knowledge map level. As in the case of all the other claims, the Examiner provides no evidence whatsoever to support his conclusory rejection of this claim. Appellants respectfully submit that this claim is patentable for at least the same reasons set forth in connection with dependent claim 27, and for the additional reason that Asplen does not disclosed the step of determining how additional value will be created by structuring a domain beyond the level of a knowledge map, whether by creation of a model or otherwise. In short, Asplen is totally silent with regard to such steps. Accordingly, the Examiner’s rejection of Claim 28 is in error and should be reversed.

XIII. DEPENDENT CLAIM 29

This claim depends from dependent Claim 27 and further characterizes the knowledge clearing house as providing direct access to explicit content of the domain. “Explicit content” is defined in the glossary. Asplen discloses neither structure nor method step relating to a “knowledge clearing house,” much less one having the characteristic as claimed in dependent Claim 29. As with the other claims, the Examiner offers no evidence in the rejection to suggest otherwise. Accordingly, the Examiner’s rejection of Claim 29 is in error and should be reversed.

XIV. DEPENDENT CLAIM 30

This claim similarly depends from Claim 27 and further characterizes the knowledge clearing house referenced in that claim. For reasons identical to those discussed immediately above in connection with dependent Claim 29, Appellants respectfully submit that the Examiner’s rejection of dependent Claim 30 is in error and should be reversed.

XV. DEPENDENT CLAIM 31

Dependent Claim 31 depends from dependent Claim 27 and adds several steps to the method of that claim. Specifically, dependent Claim 31 adds the steps of: developing an estimate of costs associated with developing a knowledge network (defined in the glossary) and developing an estimate of the value of such knowledge network; comparing the estimates of costs and value and, based upon the comparison, performing at least one of the steps of: storing and maintaining the model, the plurality of elements of information, the knowledge map and the knowledge clearing house; and developing and storing the knowledge network so as to add structure and impart value to the domain. In the context of Appellants’ application, the step of developing a knowledge network increases the degree of structure brought to the domain and necessarily imparts additional value to the domain. The addition of value occurs “necessarily” because the comparison step assures that if the costs of developing the knowledge network outweigh the value imparted by the network, the knowledge network will not be developed. For all the reasons discussed above in connection with independent Claim 19 and dependent Claim 27, and the additional reason that Asplen does not disclose a knowledge network, nor the steps of developing estimates of costs and value associated with same, Appellants respectfully submit that dependent Claim 31 defines patentable subject matter over the art of record, including the

Asplen patent. The Examiner's rejection of Claim 31 follows the same conclusory pattern set with regard to all the other claims, and is totally unsupported by any evidence in this record. Accordingly, the Examiner's rejection of Claim 31 is in error and should be reversed.

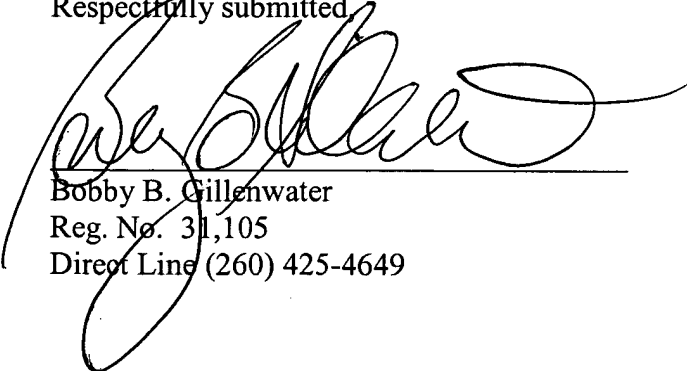
XVI. DEPENDENT CLAIM 32

Dependent Claim 32 depends from Claim 31 and further characterizes the knowledge network as comprising "a software component for providing mediated access to and managing collaboration with experts, and for providing meeting management tools." Nothing in the Asplen disclosure even suggests, much less discloses, such a software component. The Examiner's rejection, as set forth in paragraph 18 of the Detailed Action, suggests nothing to the contrary. Accordingly, the Examiner's rejection of Claim 32 is in error and should be reversed.

XVII. CONCLUSION

For the reasons set forth above, Appellants respectfully submit that Claims 19-32 on appeal are patentable over the art of record, including the Asplen patent. The Examiner's rejections of these claims based on the Asplen patent are wholly conclusory, are unsupported and are unsupportable by reference to Asplen. Accordingly, Appellants respectfully submit that the rejections of Claims 19-32 are in error and respectfully requests that these rejections be reversed.

Respectfully submitted,



Bobby B. Gillenwater
Reg. No. 31,105
Direct Line (260) 425-4649

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CLAIMS APPENDIX

THE CLAIMS ON APPEAL ARE:

19. A method of structuring contents of an unstructured domain so as to impart value to the domain, comprising the steps of:

identifying a plurality of elements of information associated with an unstructured domain;

developing an initial domain model for utilizing the plurality of elements of information associated with the domain to create value;

developing an estimate of costs associated with developing a knowledge map cataloging and describing at least some of said elements of information associated with the domain, and developing an estimate of the value of said knowledge map;

comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said plurality of elements of information; and

developing and storing the knowledge map so as to add structure and impart value to said domain.

20. The method of Claim 19, wherein the step of developing an initial domain model comprises at least one of the steps of defining an organizational scope, defining a content scope, defining a process scope, and defining economic factors relating to the domain.

21. The method of Claim 20, wherein the step of defining the organizational scope comprises the step of identifying elements of an organization affected by one or more of the plurality of elements of information associated with the domain.

22. The method of Claim 20, wherein the step of defining the content scope comprises the step of identifying at least some of the plurality of elements of information as one of explicit content and implicit content.

23. The method of Claim 22, wherein the step of identifying at least some of the plurality of elements as explicit content further comprises identifying at least some of said elements of information as at least one of online information and offline information.

24. The method of Claim 20, wherein the step of defining a process scope comprises the step of identifying a business process that can be improved by structuring contents of the unstructured domain.

25. The method of Claim 20, wherein the step of defining economic factors includes at least one of the steps of identifying costs associated with identifying and gathering at least some of the plurality of elements of information associated with the domain, identifying costs associated with detecting errors and taking actions to avoid and correct errors, identifying communication costs, and identifying costs associated with maintaining the plurality of elements of information.

26. The method of Claim 20, wherein the step of defining economic factors further comprises developing an economic model for use in developing the estimates of costs and value associated with developing the knowledge map.

27. The method of Claim 19, further comprising the steps of:

developing an estimate of costs associated with developing a knowledge clearing house, which provides centralized access to online elements of information associated with the domain and a cataloging of offline elements of information associated with the domain, and developing an estimate of the value of said knowledge clearing house;

comparing the estimates of costs and value developed in connection with the knowledge clearing house and, based on said comparison, performing at least one of the steps of:

storing and maintaining the model, said plurality of elements of information, and said knowledge map; and

developing and storing the knowledge clearing house so as to add structure and impart value to said domain.

28. The method of Claim 27, wherein the step of determining an estimate of the value of said knowledge clearing house comprises the step of creating a model for determining how additional value will be created by structuring the domain beyond the knowledge map.

29. The method of Claim 27, wherein said knowledge clearing house provides direct access to explicit content of the domain.

30. The method of Claim 27, wherein said knowledge clearing house comprises offline content, software components, and online content.

31. The method of Claim 27, further comprising the steps of:

developing an estimate of costs associated with developing a knowledge network and developing an estimate of the value of said knowledge network;

comparing the estimates of costs and value developed in connection with the knowledge network and based upon said comparison, performing at least one of the steps of:

storing and maintaining the model, said plurality of elements of information, said knowledge map and said knowledge clearing house; and

developing and storing the knowledge network so as to add structure and impart value to said domain.

32. The method of Claim 31, wherein said knowledge network comprises a software component for providing mediated access to and managing collaboration with experts, and for providing meeting management tools.

EVIDENCE APPENDIX

GLOSSARY

Certain recurring terms used in the specification are provided in this glossary to assist in better understanding the specification. This glossary is not to be construed, however, as limiting the scope of the invention, nor limiting the following Detailed Description of the Drawings, nor are any of the explanations accompanying the following terms to be construed as an exhaustive definition of that term.

"Content scope" defines the types of on-line and off-line content, information, and data resources that will be considered in the domain.

"Domain" refers to a particular body of knowledge, and a set of methods for creating, sharing and using that body of knowledge to achieve a given purpose.

"Explicit content" includes any content that is not exclusively people-based, including documents, databases, email and so on. The content can be on-line or off-line.

"Gate" is a decision point to determine if further steps in the process are warranted.

"Implicit content" is information held in the mind of an individual or collectively in the minds of teams or groups.

"Initial domain model" is refined information about the "target domain," and includes a description of the scope and economics of the domain.

"Knowledge clearinghouse" is a central agency for the collection, classification, and distribution of information or transactions within the domain.

"Knowledge map" is a device for structuring the content scope of the domain by cataloging and describing the key content sources in the domain.

"Knowledge network" is a technology-based platform and the supporting organizational structures and management practices for connecting people to people and thereby structuring the tacit knowledge in the domain.

"Off-line content" is information or knowledge in physical form, such as paper documents, files, card catalogs, and manuals.

"On-line content" is information or knowledge in electronic form, such as databases, document management systems, and email.

"Organizational scope" is the companies, departments, and key knowledge workers that fall within the definition of the domain.

"Process scope" identifies those business processes that should be improved through structuring a domain.

"Stages" are discrete activities that make up a portion of the overall process.

"Structured domains" are highly articulated bodies of knowledge and sets of methods for creating, sharing, and using knowledge to create value.

"Taxonomy" is a standardized vocabulary used to organize and define the semantics of the content within the domain.

"Unstructured domains" are domains that are less clearly defined than their more structured counterparts.